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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,482	10/27/2003	Haruji Sakugawa	63830-5029	5223

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EXAMINER

PENG, KUO LIANG

ART UNIT PAPER NUMBER

1712

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CN

**Office Action Summary**

Application No.

10/695,482

Applicant(s)

SAKUGAWA, HARUJI

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/2/06 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 2, 2006 has been entered. Claims 1 and 7 are amended. Claims 16-17 are deleted. Now, Claims 1-15 and 18-22 are pending.
2. The text of those sections of Title 35, U.S. code not included in this action can be found in previous Office Actions.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-15 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1- 15 of U.S. Patent No. 6 639 025. Although the conflicting claims are not identical, they are not patentable distinct from each other because of the following reasons: Claims 1-15 of US 6 639 025 are directed to an elastomer-modified epoxy siloxane composition prepared by combining the same ingredients in the present invention, which obviously read on those of the present invention.

***Claim Rejections - 35 USC § 112***

5. Claims 1-6 and 18-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an elastomer-modified epoxy siloxane composition comprising a polyfunctional amine curative (page 3, 1<sup>st</sup> paragraph and an elastomeric resinous intermediate having a specific resin and a specific functionality recited in page 3, 1<sup>st</sup> paragraph, does not reasonably provide enablement for an elastomer-modified epoxy siloxane composition comprising any amine curative agent and any elastomer resinous intermediate. The specification does not enable any person skilled in the art to which it pertains, or with which it is

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most nearly connected, to make and/or use the invention commensurate in scope with these claims.

6. Claims 7-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an elastomer-modified epoxy siloxane composition comprising an elastomeric resinous intermediate having a specific resin and a specific functionality recited in page 3, 1<sup>st</sup> paragraph, does not reasonably provide enablement for an elastomer-modified epoxy siloxane composition comprising any elastomer resinous intermediate. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

7. Claims 12-15 and 21-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an elastomer-modified epoxy siloxane composition comprising an elastomeric resinous intermediate having a specific resin and a specific functionality recited in page 3, 1<sup>st</sup> paragraph and an organometallic catalyst (page 4, line 31), does not reasonably provide enablement for an elastomer-modified epoxy siloxane composition comprising any elastomer

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resinous intermediate (Claim 12) and any metal catalyst (Claim 13). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

8. Claims 18 and 21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an elastomer-modified epoxy siloxane composition that is cured into a uniformly dispersed arrangement of linear epoxy chain fragments. (page 21, 2<sup>nd</sup> paragraph) does not reasonably provide enablement for an elastomer-modified epoxy siloxane composition that is cured into a uniformly dispersed arrangement of any epoxy chain fragments. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

9. Claims 3 and 13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an elastomer-modified epoxy siloxane composition comprising an organometallic catalyst (page 4, line 31) does not reasonably provide enablement for an elastomer-modified epoxy siloxane

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composition comprising any metal catalyst. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

6. Claims 1, 7 and 12 would be allowable if rewritten or amended to overcome the rejected under 35 U.S.C. 112, first paragraph and double patenting rejection, set forth in this Office action.

Mowrer (US 5,804,616) discloses an epoxy-polysiloxane polymer composition. However, it does not teach or fairly suggest the use of the elastomeric resin set forth in the present invention.

7. Claims 2-6, 8-11, 13-15 and 18-22 would be allowable if rewritten to overcome the rejected under 35 U.S.C. 112, first paragraph and/or double patenting rejection, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The patentability of the instant claims is described in the previous paragraph.


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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
April 1, 2006

  
Kuo-Liang Peng  
Primary Examiner



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